of the wall panels having an external surface, the hinged connection between the wall panels allowing the wall panels to cooperate with one another to retain the external surfaces of the wall panels at an angle greater than 180 degrees relative to one another, so that the hinged connection provides movement of the wall panels from:

a first position where the external surfaces of the wall panels are at an acute angle relative to one another to a second position where the external surfaces of the wall panels are retained at an angle greater than 180 degrees relative to one another, the wall panels cooperating with one another to retaining the external surfaces of the wall panels at the second position relative to one another; and

a pair of endwalls, each endwall being hingedly attached to said floor panel at opposing ends of the floor panel, the endwalls pivoting from a position where both endwalls lie over said floor panel to a generally normal position with said floor panel to cooperate with said wall panels when said wall panels are in said second position to retain the external surfaces of the wall panels at the second position relative to one another; and

a roof panel, the roof panel being of a weight and extending between the walls and being hingedly connected to said walls; and

at least partially supporting the roof panel with said walls when said wall panels are at the second position relative to one another, and so that the roof panel cooperates with the wall panels such that the weight of the roof panel assists in maintaining the wall panels in the second position.

REMARKS

By the present preliminary amendment, Applicants have added new claims 16-18. No new matter has been entered by said amendments, and support for said amendments is

discussed more fully, herein.

Applicants present this preliminary amendment in conjunction with a request by applicants for interference pursuant to 37 CFR 1.607 wherein applicants respectfully request that an interference be declared between the above application and U.S. Patent No. 6,408,797B2. The information required by 37 CFR 1.607(a) is set forth under headings which correspond to the subsections of 1.607 to facilitate proper consideration by the Examiner.

T.F.H. Publications Inc., the assignee of the above referenced application, also wishes to note that there is some very important background regarding this interference request that T.F.H. would first like to bring to the attention of the U.S.P.T.O. It is believed that this background information properly informs the U.S.P.T.O of the circumstances surrounding how this interference request has finally worked its way into a form for determination.

T.F.H. notes that on February 9, 2001, the purported inventors of the '797 Patent, Messrs. Pivonka and Tottleben, by and through Attorney Ramon L. Pizarro, wrote to Central Garden & Pet Company, the parent company of T.F.H. Publications, Inc. (the assignee of U.S. Appl. No. 09/914,047) representing that "several broad claims" had been found patentable in their **pending** parent application (U.S. 09/323,423, which has since issued as U.S. Patent No. 6,216,638). See **Exhibit A**. In addition Attorney Pizzaro and Messrs. Pivonka and Tottleben confirmed that they were in possession of a product manufactured and distributed by T.F.H. Publications (the "Fold-Away Pet Carrier™"). Messrs. Pivonka and Tottleben, in an initial defensive posture, advised T.F.H. Publications Inc. that notwithstanding the fact that this earlier commercial product clearly

created a *prima facie* case of unpatentability of their pending application, they were allegedly in possession of earlier records "[r]elating to inventorship and diligence towards a reduction to practice" that allegedly resurrected their rights to continue to seek patent protection.

Messrs. Pivonka and Tottleben then switched to the offensive, indicating that they considered T.F.H.'s commercially available pet carrier to be "remarkably similar" to the pet carrier that was the subject of their pending application. Then, Attorney Pivonka and Messrs. Pivonka and Tottleben, presumably convinced of the merits of their own defensive and offensive analysis, concluded that it "may be in [T.F.H.'s] best interest" to take a license under their pending application.

It is clear then that right out of the starting gate, Attorney Pizarro and Messrs. Pivonka and Tottleben were in possession of information (T.F.H.'s earlier commercial product) which was "material" to the examination of their pending application. Such earlier existing commercial product, by their own averments, established a *prima facie* case of unpatentability of their application claims, prompting them to sheepishly evaluate and report to T.F.H. on the existence of their purported records of inventorship and diligence. Yet **nowhere** in the prosecution of any of Messrs. Pivonka and Tottleben's pending applications, including U.S. Patent No. 6,408,797 (which is the subject of this interference request) will one find Messrs. Pivonka and Tottleben disclosing this material information to the U.S.P.T.O.

In fact, the withholding activities of Attorney Pizarro and Messrs. Pivonka and Tottleben continued to even higher levels. On March 19, 2001, and again while their U.S. 09/323,423 application was pending, Attorney Pizarro and Messrs. Pivonka and

Tottleben wrote once more to T.F.H., with yet a further acknowledgment of the earlier commercial success of T.F.H.'s Fold-Away Pet Carrier™ product. This time, Attorney Pizzaro and Messrs. Pivonka and Tottleben requested that T.F.H. "respond immediately" as to whether or not T.F.H. had any interest pursuing licensing discussions for both U.S. 09/323,423 and for a continuation application, which was then said to be "in process". See **Exhibit B.** On April 3, 2001, Mr. Pizarro filed U.S. Continuation Application No. 09/825,396 (claiming priority to U.S. Appln. No. 09/323,423, filed June 1, 1999) which Continuation Application ultimately issued, on June 25, 2002, as U.S. Patent No. 6,408,797 ('797). It is the '797 patent that is the subject of this interference request.

However, on July 17, 2001, **while the continuation application which matured into the '797 patent was pending,** T.F.H. wrote to Mr. Pizarro and Messrs. Pivonka and Totttleben and among other things, **confirmed in writing** that T.F.H. had made its Fold-Away Pet Carrier™ product, for which Mr. Pizarro accused T.F.H. of infringement, *prior to June 1, 1999* (the priority date of the '797 patent). **Exhibit C.** Such communication from T.F.H., on its own, clearly qualified as material information under 37 CFR 1.56 and MPEP 2001.06 (the duty to disclose material information extends to communications from or with competitors, potential infringers, or other third parties). Yet once again, Attorney Pizarro and Messrs. Pivonka and Tottleben withheld such communication from the U.S.P.T.O.

As the U.S.P.T.O can therefore see from the above, and upon examination of the prosecution record of either U.S. Patent No. 6,216,638 or 6,408,797, Attorney Pizzaro and Messrs. Pivonka and Tottleben, while demanding the *immediate* attention of T.F.H., elected *not* to bring to the *immediate* attention of the U.S.P.T.O. the fact that they were in

possession of the earlier T.F.H. commercial product and accompanying T.F.H. communications that were no doubt material to the examination of the pending '797 continuation patent application. This was certainly the case as the earlier manufactured and distributed T.F.H. Fold-Away Pet Carrier™ product in the possession of Attorney Pizzaro and Messrs. Pivonka and Tottleben, by their own allegation, fell within the scope of the pending claims of the '797 continuation application, and clearly and unambiguously, established a *prior* public use or sale and a *prima facie* case of unpatentability of their application. Yet, Attorney Pizarro and Messrs. Pivonka and Tottleben elected to withhold this information, in a compelling affront to the requirements of MPEP 2004, which makes clear that evidence of even a *possible* prior use/sale is a cornerstone of the type of material information that should be submitted. Furthermore, this is the case regardless of whatever comfort Attorney Pizarro and Messrs. Pivonka and Tottleben unilaterally derived from their purported and also withheld records of inventorship or diligence. 37 C.F.R. 1.56 (a *prima facie* case of unpatentability is established *before* any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentabilty).

In addition, T.F.H.'s earlier product, that Attorney Pizzaro and Messrs. Pivonka and Tottleben **possessed** during prosecution of the '797 patent application, also definitively raised questions of priority of inventorship under the provisions of 35 USC § 102(g). Once again, Attorney Pizzaro and Messrs. Pivonka and Tottleben elected to ignore the requirements of MPEP 2004 which unambiguously states "[w]atch out for information that might be deemed to be prior art under 35 USC §§ 102(f) and (g)." Or, stated another way, it was incumbent on Attorney Pizarro and Messrs. Pivonka and

Tottleben to disclose the growing priority conflict to the examiner and not to unilaterally make a determination that the T.F.H. Fold-Away Pet Carrier™ product was not prior art. See, *GFI, Inc. v. Franklin Corporation et al*, 265 F. 3d 1268 (Fed. Cir. 2001)(it is incumbent upon a party to disclose potential priority conflicts to the examiner and not to unilaterally make a determination in their favor); *LaBounty Mfg., Inc. v. United States Int'l Trade Comm'n*, 958 F.2d 1066, 1076, 22 U.S.P.Q.2D (BNA) 1025, 1033 (Fed. Cir. 1992) (It is axiomatic that "close cases should be resolved by disclosure, not unilaterally by applicant.").

Simply stated, it is believed that there is little doubt that had the Examiner who allowed the application that matured into the '797 patent been made aware of the T.F.H. product that was known to be commercialized prior to the priority date of the '797 continuation patent application, the Examiner would have certainly and reasonably requested, under the provisions of 37 C.F.R. 1.105 and MPEP 706.02(c), that Attorney Pizarro and Messrs. Pivonka and Tottleben offer evidence that T.F.H.'s commercial product did *not*: 1. establish itself as prior art under 35 USC § 102(a); 2. establish itself as a prior public use or sale under 35 USC § 102(b); 3. establish priority of invention to T.F.H. under 35 USC § 102(g); and/or 4. establish itself as prior art under 35 USC 102/103 thereby rendering the subject matter of the '797 patent as obvious. However, Attorney Pizarro and Messrs. Pivonka and Tottleben had a much different strategy rather than allowing the U.S.P.T.O. the opportunity to properly evaluate these issues.

Specifically, instead of fully disclosing material prior art to the U.S.P.T.O., and the existence of the *prima facie* case of unpatentability of their pending claims and/or the priority conflict, Attorney Pizarro and Messrs. Pivonka and Tottleben were collectively

determined to withhold such material information and have U.S. Patent 6,408,797 issue as soon as possible (along with their U.S. 6,216,638) so that they could file suit against Central Garden & Pet Company, Nylabone Corporation and TFC Publications, Inc. (sic). Attorney Pizarro and Messrs. Pivonka and Tottleben thereby elected to deny the U.S.P.T.O. the opportunity to properly investigate and determine, in the interests of the public, whether they were entitled to the grant of either of their '638 or '797 patents *before* relying upon such patents to initiate infringement litigation. See **Exhibit D**.

T.F.H. therefore submits the present request for interference so that the U.S.P.T.O. can tend to its administrative authority and place the award of priority of invention to that party that was indeed, the first to invent, and which party has satisfied, among other things, the requirements of 35 USC 102/103. T.F.H. therefore looks forward to the U.S.P.T.O exercising its proper authority at this time, notwithstanding Attorney Pizarro's and Messrs. Pivonka and Tottleben's efforts to steer clear of this inquiry, and T.F.H. respectfully notes the following in support of its request.

I. IDENTIFICATION OF THE PATENT WHICH INCLUDES SUBJECT MATTER WHICH INTERFERES WITH THE APPLICATION

The patent which claims subject matter which interferes with subject matter claimed in the present application (the '047 application) is U.S. Patent No. 6,408,797B2 (the '797 Patent), issued on June 25, 2002 to Pivonka et al for "Collapsible Pet Carrier". The '797 Patent was issued on application Serial No. 09/825,396, which purports on its face to be a continuation of application Serial No. 09/323,423, filed on June 1, 1999, now U.S. Patent No. 6,216,638.

II. PRESENTATION OF A PROPOSED COUNT

Attached **Exhibit E** sets forth a proposed count. The proposed count has been prepared after consideration of the subject matter claimed by the respective parties.

III. IDENTIFICATION OF A CLAIM OF THE '797 PATENT WHICH CORRESPONDS TO THE PROPOSED COUNT

Claims 1, 5 and 9 of the '797 patent are believed to correspond to the proposed count. In order to assist the Examiner, attached **Exhibit F** sets forth a side-by-side comparison of Claim 5 of the '797 patent with the proposed count.

IV. CLAIMS OF THE '047 APPLICATION WHICH CORRESPOND TO THE PROPOSED COUNTS

Newly added claims 16-18 of the '047 application are believed to correspond to the proposed count. To assist the Examiner in this regard, Applicants attach **Exhibit G** and **H**. **Exhibit G** is a chart providing an element-by-element recitation of the newly added claims 16-18 of the '047 application and an indication of where in the originally filed application, and at the very least, the claims find support. **Exhibit H** is a chart providing a side-by-side comparison of claim 17 of the '047 application with the proposed count.

In addition, it is useful to note that the Messrs. Pivonka and Tottleben (the applicants of the U.S. '797 patent) in their Complaint filed with the United District Court of Colorado (**Exhibit D**), submitted a photograph of T.F.H.'s carrier (**Exhibit I**), which is

identical to FIG. 1 of the present T.F.H. '047 application. Messrs. Pivonka and Tottleben alleged that such photograph supported the allegation that the T.F.H. Fold-Away Pet Carrier™ product infringed one or more claims of the '797 patent. As the U.S.P.T.O can see, claims 16-18 herein are duplicates of claims 1, 5 and 9 of the '797 patent.

Accordingly, it is clear that Messrs. Pivonka and Tottleben are necessarily of the opinion that claims 16-18 added by preliminary amendment herein are all properly supported by the specification of the '047 application.

V. 35 USC § 135(b) IS SATISFIED

Less than one year has passed since the '797 patent has issued. Thus, the requirements of 35 USC § 135(b) are satisfied.

VI. CONCLUSION

Applicants respectfully request that an interference be declared employing the proposed count set forth on attached **Exhibit E** with claims 1, 5 and 9 of the '797 patent and claims 16-18 of the '047 application as corresponding to the count. Such action is respectfully requested.

Furthermore, it is noted that the present '047 application is the latest in a chain of continuation applications which include Serial No. 09/255,117, filed February 22, 1999, now U.S. Patent No. 5,950,568; and Serial No. 09/266,389, now abandoned, and Serial No. 09/334,529, now U.S. Patent No. 6,131,534. See **Exhibit J**. Accordingly, the present '047 application should be accorded the benefit of these prior applications in the declaration of interference. The '047 application should also be designated as the senior

party in the interference as having the earlier effective filing date, i.e., February 22, 1999 versus June 1, 1999 for the '797 patent.

In the event there are any deficiencies, or additional fees are payable, please charge them (or credit any overpayment) to our deposit account No. 50-2121.

Respectfully submitted,

Steven J. Grossman
Attorney for Applicant
Reg. No. 35,001
Grossman, Tucker, Perreault & Pfleger, PLLC
55 South Commercial Street
Manchester, New Hampshire 03101

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I hereby certify that this paper and the papers listed thereon are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above, and is addressed to Commissioner for Patents, Washington, D.C. 20231.

Signature of person mailing: Carol McClelland

Name of person mailing: Carol McClelland